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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/724,688 | 12/02/2003 | Kieran O'Keefe | 025538-00044 | 1986 |

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| EXAMINER |
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ISMAL, SHAWKI SAIF

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| ART UNIT | PAPER NUMBER |
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2155

DATE MAILED: 01/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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|------------------------------|-------------------------------|---------------------------------|--|
| Office Action Summary | Application No. 10/724,688 | Applicant(s) O'KEEFFE ET AL. | |
| | Examiner Shawki S. Ismail | Art Unit 2155 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12/2/03 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is responsive to the application filed on December 2, 2003. Claims 1-54 are presented for examination.

Priority

2. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in United Kingdom on August 22, 2003. It is noted, however, that applicant has not filed a certified copy of the GB0319861.1 application as required by 35 U.S.C. 119(b).

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 20, 21, 35, 47 and 48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear to the Examiner if the first, second, and third server components are a part of one server or if they are each servers themselves. For the sake of expediting prosecution examiner hereby interprets the first server component to be for example an e-commerce server, second server component to be the recipients mail server, and the third server component to be the actual electronic message.

Claim Rejections - 35 USC §102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

6. Claims 1-54, are rejected under 35 U.S.C. 102(e) as being anticipated by **Fortenberry et al.**, (Fortenberry) U.S. Patent No. **6,101,485**.

7. As to claim 1, Fortenberry teaches a system for conducting a transaction via an electronic mail message, the system comprising:

a first server component for sending an electronic mail message to a recipient (col. 2, lines 21-33, an e-commerce site sends an electronic message to a potential shopper);

a second server component for receiving data (col. 2, lines 21-33, a potential shopper receives an electronic message from an e-commerce);

a third server component for effecting a transaction in response to data received by the second server component (col. 1, line 66 – col. 2, line 6, the electronic sent by the e-commerce site to the potential shopper is a e-flyer) ;

a client mail application for receiving the electronic mail message from the first server component, displaying the message to the recipient and enabling a recipient to interact with the message (col. 2, lines 21-33, a potential shopper receives an electronic message from an e-commerce through e-mail sever);

the electronic mail message comprising content that includes means for enabling communication with the second server component whilst the message is displayed to the recipient for sending data to the second server component in response to the recipient's interaction with the message (col. 2, lines 21-41, the buyer can interact with the e-flyer from within the e-mail without having to go to the e-commerce site.)

8. As to claim 2, Fortenberry teaches a system according to claim 1, comprising one or more server components for sending data to the mail message to enable two-way communication between an electronic mail message displayed to the recipient and one or more server components (col. 2, lines 21-41).

9. As to claim 3, Fortenberry teaches a system according to claim 1 wherein the content of the electronic mail message for enabling communication with the second server component comprises an object or component embedded in the message (col. 3, lines 45-59).

10. As to claim 4, Fortenberry teaches a system according to any one of claims 1, wherein the content of the electronic mail message for enabling communication with the second server component comprises means for loading on or after opening of the

message an object or component to be displayed within the mail message to the recipient (col. 2, lines 21-41).

11. As to claim 5, Fortenberry teaches a system according to claim 4 wherein the object or component comprises a mail reader application component or enhancement that provides a dynamic environment with which a recipient of the message can interact (col. 4, line 66 – col. 5, line 24).

12. As to claim 6, Fortenberry teaches a system according to claim 5 wherein the object or component comprises a plug-in component or virtual machine (col. 3, lines 46-59).

13. As to claim 7, Fortenberry teaches a system according to claim 6 wherein the object or component comprises a flash movie (col. 3, lines 46-59).

14. As to claim 8, Fortenberry teaches a system according to claim 6 wherein the object or component comprises a Java applet (col. 3, lines 46-59).

15. As to claim 9, Fortenberry teaches a system according to claim 4 wherein the object or component comprises means to validate data entered by a recipient of the message (col. 4, line 66 – col. 5, line 24).

16. As to claim 10, Fortenberry teaches a system according to claim 9 wherein the means to validate data operates to validate the data with reference to rules or data held locally by the object or component (col. 4, line 66 – col. 5, line 24).

17. As to claim 11, Fortenberry teaches a system according to claim 9 wherein the means to validate data comprises means for communicating with a server component to validate data with reference to external rules or data sources (col. 5, lines 15-24).

18. As to claim 12, Fortenberry teaches a system according to claim 4 wherein the object or component is sand-boxed (col. 3, line 45-59).

19. As to claim 13, Fortenberry teaches a system according to claim 1 wherein the electronic mail message includes alternative content that is visible to the recipient in the event that the means for communicating with the second server component is inoperable (col. 5, lines 25-43).

20. As to claim 14, Fortenberry teaches a system according to claim 1 comprising a server component for generating the electronic mail message to be sent (col. 2, lines 21-41).

21. As to claim 15, Fortenberry teaches a system according to claim 14, comprising a store of one or more mail message templates accessible by the server component for generating the electronic mail message (col. 3. line 60 – col. 4, line 12).

22. As to claim 16, Fortenberry teaches a system according to claim 1 wherein the electronic mail message is personalized for a particular recipient or group of recipients (col. 3. line 60 – col. 4, line 12).

23. As to claim 17, Fortenberry teaches a system according to claim 1, wherein the third server component comprises means for storing the received data in a data store (col. 4, line 66 – col. 5, line 24).

24. As to claim 18, Fortenberry teaches a system according to claim 1, wherein the third server component comprises means for forwarding the data to another address, application, service or system (col. 4, line 66 – col. 5, line 24).

25. As to claim 19, Fortenberry teaches a system according to claim 1, wherein the third server component comprises means for interacting with one or more payment gateways and/or other applications, services or systems responsible for fulfillment of an order (col. 4, line 66 – col. 5, line 24).

26. Claims 20-54 do not teach or define any new limitation above claims 1-19; therefore, they are rejected for similar reasons.

27. **Examiner's note:** Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in its entirety as potentially teaching of all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shawki S Ismail whose telephone number is 571-272-3985. The examiner can normally be reached on M-F 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached at 571-272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Shawki Ismail
Patent Examiner
January 7, 2006



SALEH NAJJAR
SUPERVISORY PATENT EXAMINER